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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,841	03/26/2004	Blayn W. Beenu	70655.0500	2840

20322 7590 01/30/2006

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EXAMINER

NGUYEN, NAM V

ART UNIT

PAPER NUMBER

2635

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/708,841	<b>Applicant(s)</b> BEENAU ET AL.	
	<b>Examiner</b> Nam V. Nguyen	<b>Art Unit</b> 2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/04; 4/04; 3/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The application of Beenau et al. for a “biometric safeguard method with a fob” filed March 26, 2004 has been examined.

This application is a CIP of 10/340,352 filed January 10, 2003,  
which is a CIP of 10/192,488 filed July 9, 2002,  
which claims the benefit of 60/304,216 filed July 10, 2001 and said 10/340,352 filed January 10, 2003, which is a CIP of 10/318,432 filed December 13, 2002 and is a CIP of 10/318,480 filed December 13, 2002, and is a CIP of 60/396,577 filed July 16, 2002.

Claims 1-12 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase “authorizing said transaction that violates an established rule to proceed upon verification of the proffered biometric sample” is confusing and unclear. It is not

Art Unit: 2635

understood what is meant by such a limitation. Is authorizing said transaction if an established rule is violated? Where is this limitation supported by specification? Claims 2-12 are rejected for their dependence on Claim 1 and include the same limitations of Claim 1 without correcting the ambiguity.

In claim 1, the phrase “detecting a proffered biometric at a sensor communicating with said system to obtain a proffered biometric sample” is confusing and unclear. It is not understood what is meant by such a limitation. Is a sensor detecting a proffered biometric sample? Is the sensor located in the transponder, in a reader or in a system? What is the difference between a proffered biometric and a proffered biometric sample? Where is this limitation supported by specification?

In claim 5, the phrase “detecting includes at least one of: detecting, storing, and processing a proffered biometric sample” is confusing and unclear. It is not understood what is meant by such a limitation. What detecting means here? Where is this limitation supported by specification?

In claim 6, the phrase “detecting further includes receiving a finite number of proffered biometric samples during a transaction” is confusing and unclear. It is not understood what is meant by such a limitation. What detecting means here? What is a finite number? Where is this limitation supported by specification?

In claim 7, the phrase “wherein said step of detecting includes logging each proffered biometric sample” is confusing and unclear. It is not understood what is meant by such a limitation. What detecting means here? Where is this limitation supported by specification?

In claim 8, the phrase “wherein said step of detecting further includes at least one of detection, processing and storing at least one second proffered biometric sample” is confusing and unclear. It is not understood what is meant by such a limitation. What detecting means here? Where is this limitation supported by specification?

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita (US# 6,703,918) and in view of Maes et al. (US# 6,016,476).

Referring to claim 1, Kita discloses a method for facilitating biometric security in a transponder-reader transaction system (i.e. a portable information system) (column 1 line 64 to column 2 line 38; see Figures 1-4), said method comprising:

detecting a proffered biometric (i.e. fingerprint) at a sensor (8) communicating with said system to obtain a proffered biometric sample (i.e. authentication data) (column 4 lines 20 to 59; column 10 line 62 to column 11 line 14; see Figures 1-3 and 10-11);

verifying the proffered biometric sample (i.e. authentication data) (column 4 line 60 to column 5 line 9; column 6 line 44 to column 7 line 28; column 11 lines 15 to 61; see Figures 3 and 6-7); and

authorizing a transaction upon verification of the proffered biometric sample (column 7 lines 28 to 67; column 11 lines 62 to 68; see Figures 6-7 and 10-11).

However, Kita did not explicitly disclose determining if a transaction violates an established rule.

In the same field of endeavor of portable information and transaction processing system, Maes et al. teach that determining if a transaction violates an established rule (i.e. verification of data or validity digital certificate of the portable device) (column 6 line 56 to column 8 line 65; see Figures 1 to 4) in order provide a connection link to the central server for processing of a transaction prior to verify a user biometric identity.

One of ordinary skilled in the art recognizes verifying data or digital certificate of a portable device prior to a user's biometric verification taught by Maes et al. in a verification of biometric sample of a portable information equipment of Kita because Kita suggests it is desired to provide that the portable information equipment includes plurality of biometric sensors to authenticate the user (column 10 line 62 to column 12 line 40; column 14 lines 42 to 61; see Figures 10-15) and Maes et al. teach that a user prompted to provide verification data to central server for transaction process and also to provide verification of a biometric of a user (column 8

Art Unit: 2635

line 28 to column 10 line 28; see Figure 4) in order to increase security for access control and to prevent another person using the portable device. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to verify data or digital certificate of a portable device prior to a user's biometric verification taught by Maes et al. in a verification of biometric sample of a portable information equipment of Kita with the motivation for doing so would have been to secure the verification of the user in the identity verification system for e-commerce.

Referring to claim 2, Kita in view of Maes et al. disclose method of claim 1, Maes et al. disclose wherein said step of determining if a transaction violates an established rule includes determining if said transaction is at least one of a purchase exceeding an established per purchase spending limit, a purchase exceeding a preset number of transactions, any portion of a purchase using non-monetary funds, and a purchase exceeding an established limit (column 7 lines 36 to 56; column 9 line 65 to column 10 line 17; see Figures 1 to 4).

Referring to claim 3, Kita in view of Maes et al. disclose method of claim 1, Maes et al. disclose wherein said step of notifying includes providing notification by at least one of an audible signal (36) (i.e. by speaker), visual signal (34) (i.e. user interface display), blinking, signaling and beeping to said user (column 5 line 36 to column 6 line 55; see Figure 1).

Referring to claim 4, Kita in view of Maes et al. disclose method of claim 1, Kita discloses wherein said step of detecting further includes detecting a proffered biometric (i.e. a

Art Unit: 2635

fingerprint) at a sensor (8) (i.e. a fingerprint sensor section) configured to communicate with said system (32) via at least one of a transponder (6) (i.e. a radio communication section) (column 4 line 20 to column 5 line 9; see Figures 1-3 and 10-11).

Referring to claim 5, Kita in view of Maes et al. disclose method of claim 1, Kita discloses wherein said step of detecting includes at least one of: detecting, storing, and processing a proffered biometric sample (i.e. authentication data) (column 4 line 20 to column 5 line 9; see Figures 1-3 and 10-11).

Referring to claim 6, Kita in view of Maes et al. disclose method of claim 1, Kita discloses wherein said step of detecting further includes receiving a finite number of proffered biometric samples during a transaction (column 4 line 20 to column 5 line 9; column 10 line 62 to column 11 line 61; see Figures 1-3 and 10-11).

Referring to claim 7, Kita in view of Maes et al. disclose method of claim 1, Kita discloses wherein said step of detecting includes logging each proffered biometric sample (i.e. authentication data) (column 5 lines 55 to column 6 line 43; column 9 line 66 to column 10 line 13).

Referring to claim 8, Kita in view of Maes et al. disclose method of claim 1, Kita discloses wherein said step of detecting further includes at least one of detection, processing and



Art Unit: 2635

storing at least one second proffered biometric sample (i.e. authentication data) (column 9 line 66 to column 10 line 36).

Referring to claim 9, Kita in view of Maes et al. disclose method of claim 1, Kita discloses wherein said step of verifying includes comparing a proffered biometric sample (i.e. inputted authentication data) with a stored biometric sample (i.e. organic authentication registration data registered in the organic authentication registration data unit 154) (column 11 line 42 to 61; see Figure 10).

Referring to claim 10, Kita in view of Maes et al. disclose method of claim 9, Kita discloses wherein comparing a proffered biometric sample (i.e. inputted authentication data) with a stored biometric sample (i.e. organic authentication registration data) includes comparing a proffered biometric sample with at least one of a biometric sample of a transponder user (i.e. user of a portable information equipment 1) (column 11 line 42 to 61; see Figure 10).

Referring to claim 11, Kita in view of Maes et al. disclose method of claim 1, Kita discloses wherein said step of verifying includes verifying a proffered biometric sample using information contained on at least one of a local database (i.e. an organic authentication registration data at the equipment 154) (column 11 line 42 to 61; see Figure 10).

Referring to claim 12, Kita in view of Maes et al. disclose method of claim 1, Kita discloses wherein said step of verifying includes verifying a proffered biometric scan sample (i.e.

Art Unit: 2635

inputted authentication data) using one of a protocol/sequence controller (152) (i.e. a control circuit) and a third-party security vendor (37) (i.e. service business) (column 5 line 40 to column 7 line 52; column 10 line 62 to column 11 line 67; see Figure 1-7 and 10-11).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/708,824 in view of Maes et al. (US# 6,016,476).

This is a provisional obviousness-type double patenting rejection.

Referring to claims 1-12, copending Application NO. 10/708,824 claims a transponder-reader transaction system which is the same as of claims 1-12 of Application NO. 10/708,841,

however, copending Application NO. 10/708,824 did not explicitly claim include determining if a transaction violates an established rule.

In the same field of endeavor of portable information and transaction processing system, Maes et al. teach that determining if a transaction violates an established rule (i.e. verification of data or validity digital certificate of the portable device) (column 6 line 56 to column 8 line 65; see Figures 1 to 4) in order provide a connection link to the central server for processing of a transaction prior to verify a user biometric identity.

One of ordinary skilled in the art recognizes verifying data or digital certificate of a portable device prior to a user's biometric verification taught by Maes et al. in the transponder-reader transaction system of a copending Application No. 10/708,824 because a copending Application No. 10/708,824 suggests to verifying biometric same and identify transaction account rule information established by the fob issuer (paragraph 0115; paragraph 0133; paragraph 0159) and Maes et al. teach that a user prompted to provide verification data to central server for transaction process and also to provide verification of a biometric of a user (column 8 line 28 to column 10 line 28; see Figure 4) in order to increase security for access control and to prevent another person using the portable device. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to verify data or digital certificate of a portable device prior to a user's biometric verification taught by Maes et al. in the transponder-reader transaction system of a copending Application No. 10/708,824 with the motivation for doing so would have been to secure the verification of the user in the identity verification system for e-commerce.

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kinsella (US# 6,914,517) disclose a fingerprint sensor with feature authentication.

Hamid et al. (US# 6,877,097) disclose a security access method and apparatus.

Glass et al. (US# 6,332,193) disclose a method and apparatus for security transmitting and authenticating biometric data over a network.

Black (US# 6,307,956) discloses a writing implement for identity verification system.

Pare, Jr. et al. (US# 6,154,879) disclose a tokenless biometric ATM access system.

Hsu et al. (US# 6,041,410) disclose personal identification fob.

DiMaria (US# 5,995,014) discloses biometric interface device for upgrading existing access control units.

Sehr (US# 5,875,432) discloses a computerized voting information system having predefined content and voting templates.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nam V Nguyen whose telephone number is 571-272-3061. The examiner can normally be reached on Mon-Fri, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 571-272-3068. The fax phone numbers for the

Art Unit: 2635

organization where this application or proceeding is assigned are 571-273-8300 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nam Nguyen  
January 25, 2006



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